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OFFICE OF PETITIONS

In re Application of	:	
Ryu, et al.	:	
Application No. 09/882,043	:	DECISION
Filed: 18 June, 2001	:	
Attorney Docket No. AB-1604 US	:	

This is a decision on the petitions filed on 3 February, 2009, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

NOTE: *The address on the petition is different than that of record.*

If Petitioner desires to receive future correspondence regarding this application, the appropriate Notice must be submitted.

A courtesy copy of this decision will be mailed to Petitioner.

However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

The petition as considered under 37 C.F.R. §1.137(b) is **GRANTED**.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to a final Office action mailed on 18 May, 2004, with reply due absent extension of time on or before 18 August, 2004.

On 13 August, 2004, Petitioner (former Counsel) filed *inter alia*, an after-final amendment, which Petitioner as one registered to practice before the Office is aware is not of right and was not a proper reply,¹ and the Examiner mailed an Advisory Action on 16 September, 2004.

On 17 November, 2004, Petitioner filed a request and fee for extension of time and a Notice of Appeal and fee.

On 14 January, 2005, Petitioner filed a request for continued examination (RCE) with fee and a submission under 37 C.F.R. §1.114 in the form of an information disclosure statement (IDS), however, the RCE was an improper RCE because Petitioner failed to satisfy the reply requirements of under 37 C.F.R. §1.114 in that the submission in reply to an Office action after final, after an *ex parte Quayle* action, or after Notice of Appeal must satisfy the requirements of 37 C.F.R. §1.111. (See: MPEP §706.07(h)(II))

The application went abandoned by operation of law after midnight 18 January, 2005.

The Office mailed a Notice of Abandonment on 28 June, 2005.

On 27 July, 2005, Petitioner filed a petition and averred non-receipt of a Notice of Improper RCE, however, Petitioner—as one registered to practice before the Office—is aware that such Notice is not required in that the triggering event (as discussed above) was Petitioner's failure to reply timely and properly to the final Office action mailed on 18 May, 2004. Because Petitioner failed to support the petition properly consistent with the express requirements set forth in the Commentary at MPEP §711.03(c)(I), the petition was dismissed on 8 December, 2008.

On 3 February, 2009, Petitioner filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b) averring unintentional delay, a reply in the form of (the previously submitted request for continued examination (RCE) and fee and) a submission under the provisions of 37 C.F.R. §1.114 in the form of an amendment, and made the statement of unintentional delay (supplied by prior Counsel).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

¹ A proper reply is an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission under 37 C.F.R. §1.114). (See: MPEP §711.03(c).)

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁴))

As to Allegations of Unintentional Delay

It appears that the requirements under 37 C.F.R. §1.137(b) have been satisfied.

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to the Technology Center/AU 2814 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See *Changes to Patent Practice and Procedure*, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁵) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



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⁵ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.